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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/396,381	09/15/1999	SHUNPEI YAMAZAKI	0756-2027	7365

31780 7590 12/02/2003

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EXAMINER

ANGEBRANDT, MARTIN J

ART UNIT	PAPER NUMBER
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1756

DATE MAILED: 12/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/396,381

Applicant(s)

YAMAZAKI ET AL.

Examiner

Martin J Angebranndt

Art Unit

1756

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) 1-5,8-12,14-19,22-26,28-33,36-40,42-47,50-54,56-66,68-77,79-88,90-99,101-110,112-121,123-132,134-143,145-154,156-165 & 167-170 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

- 5) ☒ Claim(s) See Continuation Sheet is/are allowed.
- 6) ☐ Claim(s) See Continuation Sheet is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |                                                                                              |                                                                             |
|----------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

U.S. Patent and Trademark Office  
PTO-326 (Rev. 04-01)

**Office Action Summary**

Part of Paper No. 12012003

Continuation of Disposition of Claims: Claims allowed are 1-5,15-19,29-33,43-

47,57,59,66,68,70,79,81,90,92,101,103,112,114,123,125,134,136,145,147,156 and 158.

Continuation of Disposition of Claims: Claims rejected are 8-12,14,22-26,28,36-40,42,50-54,56,58,60-65,69,71-77,80,82-88,91,93-99,102,104-110,113,115-121,124,126-132,135,137-143,146,148-154,157,159-165 and 167-170.

Art Unit: 1756

1 The response provided by the applicant has been read and given careful consideration.

Responses to the arguments offered by the applicant are presented after the first rejection to which they are directed.

2 The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3 Claims 8-12,14,22-26,28,36-40,42,50-54,56,58,60,69,71-77,80,82-88,91,93-99,102, 104-110,113,115-121,124,126-132,135,137-143,146,148-154,157,159-165 and 167-170 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of U.S. Patent 6,171,674 (including the particulars of 6, 17, 20, 24-26, 29-31, 34,36,39,41,43,46,47,68,63,64,67,27,32,37,42,44,51,58,95, 103,106,107, 110,111,114,115,116,119,120,121,124-126,129-131 and 134). Although the conflicting claims are not identical, they are not patentably distinct from each other **because it would have been obvious to one skilled in the art to use the media in a manner congruent with their only possible use.**

Art Unit: 1756

The applicant states thea the reference is not prior art. This is true for other types of rejection, but not double patenting which deals specifically with unwarranted timewise extensions of coverage accorded by patented claims. The use of optical recording media is quite obvious to the casual readere, as well as, one of ordinary skill in the art. The granting clpaims directed to the nominal use of the media described in U.S. Patent 6,171,674 would constitute a de facto extension of the coverage accorded the media. The recitation of at least one of silicon and phosphorous in the protective layer appears in claims 5,6,19,26,29,36,39,46,68,97-

101,106,114,119,124,129,134,147,152,162,168 and 172.

4 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin Angebranndt whose telephone number is (703) 308-4397.

I am normally available between 7:30 AM and 5:00 PM, Monday through Thursday and 7:30 AM and 4:00 PM on alternate Fridays.

If repeated attempts to reach me are unsuccessful, my supervisor may be reached at (703) 308-4552.

Facsimile correspondence should be directed to (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.



Martin J. Angebranndt  
Primary Examiner, Group 1750  
December 1, 2003